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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/746,716	12/22/2000	Gary W. Grube	276440-11	1179
27521	7590	12/22/2004	EXAMINER	
KEN BURRASTON KIRTON & MCCONKIE PO BOX 45120 SALT LAKE CITY, UT 84145-0120			ABRAMS, NEIL	
			ART UNIT	PAPER NUMBER
			2839	

DATE MAILED: 12/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/746,716

Applicant(s)

GRUBE ET AL.

Examiner

Neil Abrams

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) ☒ Claim(s) 1-14, 16-33, 35-51, 61-84 is/are pending the application.

4a) Of the above claim(s) 9, 11, 16-21, 43, 44, 64, 68 is/are withdrawn from consideration.

5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

6) ☒ Claim(s) All non-withdrawn is/are rejected.

7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

Note, for rejections below, that this case being a CIP is not necessarily entitled to filing date benefit of earlier cases in absence of evidence as would be pertinent where priority date is at issue.

Claim 16, note dependency from cancelled claim.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-8, 10-15, 17-51, 61-63, 65-67, 69-84 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15 of U.S. Patent No. 6,811,406. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of this case which call for "post beam" and "tip" define broadened variations of parent case claims.

Since the case used in this rejection has issued, a terminal disclaimer is now required.

The indicated allowability of claim 22 over patents to others is withdrawn.

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Claims 1-8, 10, 13-14, 30, 21, 31, 32, 35-40, 61-63, 66, 67, are rejected under 35 U.S.C. 103(a) as being unpatentable over White in view of Fjelstad, Beaman 615, Hosoi, and Love.

White, Fjelstad and Beaman 614 are applied as in last office action.

The White post (core) <sup>does not</sup> ~~does not~~ include an overcoat of a harder material. It would have been obvious to use an overcoat of material such as nickel in view of Love, fig. 2 at 25 and Hosoi, fig. 2, etc at ~~4~~ 3 and Beaman 551. The nickel is used to aid soldering and lowers stress as in Love and to lessen oxidation when used with gold as in Hosoi. Note that White at 21 uses gold to lessen oxidation and that a nickel layer is typically used <sup>under</sup> ~~under~~ a gold layer. Obvious to add such nickel layer to post 16 of White for reasons noted above. Nickel is also seen to be harder than the copper used for post 16. Use of gold over nickel further shown by Beaman 551 to be well known. Dependent claims are not seen to be separately at issue.

Claims 70-73, 77-80 and 81-84 are rejected under 35 U.S.C. 103(a) as being unpatentable over White in view of Beaman <sup>551</sup> Hosoi and Love.

The patents are applied as above.

Claims 22-29, 74-76 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eldridge '315 in view of Kanji.

Eldridge fig. 1, discloses a column <sup>with</sup> ~~a~~ wire 12 and a contact 14. The wire lacks a shell. It would have been obvious to add nickel and gold plating in view of Kanji, fig. 1D, for improved soldering. The platings are read as shells. For claims 23, 24, the nickel would be harder than copper. Other claims are not at issue.

Claims 1, 3, 4, 6-8, 10, 12, 22-30, 70-74 and 74-76 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Beaman 551.

For claim 22, Beaman figs. 1-9 shows a contact structure with plural columns each one with wire core elements 15 and overcoats 17 and a contact element 61 at the column tops, the columns fixed to base 11. Should issues arise, recited features considered obvious variations. For claim 23-24, obvious the plating 17 would be more rigid than the wires 15 since the wires are typically copper while nickel is usable for the plating, col. 5, lines 50-55. For claim 1 above discussion applied; obvious to use copper for the core which would be <sup>softer</sup> ~~safer~~ than the nickel plating. The Beaman contacts while deflectable are also readable as substantially rigid <sup>since</sup> ~~since~~ the deflection need only be very slight. Dependent claims do not appear to be independently at issue.

As alternative obvious to form the columns 15, 17 to be of greater rigidity if higher forces were required.

As another alternative, for claims 1, etc, obvious to use rigid fig. 10 probes 71 with addition of sharp projections 19 (Figs. 2, 9) the projections being contacts joined to ends of the columns.

The following is an examiner's statement of reasons for allowance: claim 41 overcomes Beaman 614, fig. 1, since beams 24 cannot properly be read as joined to "tops" of the columns 22, the terms read in light of disclosure.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably

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accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."


Applicant's arguments filed with the amendment have been fully considered but they are not persuasive. References are now applied to show the features at issue.

Claims 33, 41, 45-51 and 65 are directed to allowable subject matter apart from double patenting rejection.

Any inquiry concerning this communication should be directed to Neil Abrams at telephone number (571)272-2089.

Abrams/ds

12/17/04

  
NEIL ABRAMS  
EXAMINER  
ART UNIT 2839